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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,811	12/02/2003	Francis Emmerson	042933/308284	4120

826 7590 04/03/2007
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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/726,811

Applicant(s)

EMMERSON ET AL.

Examiner

Naghmeh Mehrpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/07 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-18**, are rejected under 35 U.S.C. 102(e) as being anticipated by Maxwell (US Publication 20040148229 A1).

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Regarding claims 1, 8-12, 17-19, Maxwell teaches a mobile service system/method comprising a wireless client for a user and a remote service provider unit for providing content to the client (0164-0165), wherein the service provider unit comprises:

- a memory for storing an application usable by the client both off-line and on-line;
- a port for receiving a request for the application from the client and for sending the application to the client (0038);

- a processor for providing on-line use of the **downloaded** application for the client (0170);

- a monitor for monitoring the on-line use of the application (0039);

- a controller configured to control the processor to provide the on-line use of the application dependent on the monitoring (0052); and Maxwell inherently teaches the client comprising:

- a port for communicating with the service provider unit, configured to send the request to the service provider unit and to receive the **downloaded** application from the service provider unit **in the form of a downloaded application from the service provider unit to the client** (0200);

- a processor for off-line running the application whenever desired by the user and for on-line running the **downloaded** application when desired by the user if allowed by the controller (0040, 0050, 0057, 0200).

Regarding claim 2, Maxwell teaches a system according to claim 1, wherein the application is a game **downloaded** application (0075-0076).

Regarding claim 3, Maxwell teaches a system according to claim 1, wherein the monitor has been configured to keep account of available on-line use of the **downloaded** application and to decrement the available on-line use according to predetermined reduction criterion (0070).

Regarding claim 4, Maxwell teaches a system according to claim 1, further comprising a charging unit configured to collect a monetary charge for the sending of the **downloaded** application and for providing a certain amount of on-line use. (0074)

Regarding claim 5, Maxwell teaches a system according to claim 1, wherein the memory comprises a plurality of applications amongst which the client may select an application to be downloaded (0043, 0177).

Regarding claim 6, Maxwell teaches a system according to claim 1, further comprising means for informing the user when the amount of available on-line use is falling below a certain threshold (0175).

Regarding claim 7, Maxwell teaches a system according to claim 1, wherein the service provider unit further comprises means for determining a payment of a supplementary charge and increasing by a corresponding amount the available on-line use (0063).

Regarding claims 13-16, Maxwell teaches a computer program product comprising means for causing a network entity to provide content to a wireless client, comprising:

computer executable program code configured to enable the network entity to store an application usable by the client both off-line and on-line **in the form of a downloaded application from the network entity to the client** (0171-0176);

computer executable program code configured to enable the network entity to receive a request for the **downloaded** application from the client and for sending the application to the client (0183);

computer executable program code configured to enable the network entity to provide on-line use of the **downloaded** application for the client (0183-188);

computer executable program code configured to enable the network entity to monitor on-line use of the **downloaded** application (0168-0171); and

computer executable program code configured to enable the network entity to control the providing of the on-line use of the **downloaded** application dependent on the monitoring of the on-line use of the application (0168-0173).

Response to Arguments

3. Applicant's arguments filed 1/16/07 have been fully considered but they are not persuasive.

In response to the applicant's a that "*Maxwell fails to teach every elements of any of the claims.*"

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Examiner asserts Maxwell teaches a system, method, and computer program product for purchasing software online is provided. The system, method, and computer program product includes developing software for purchase on a computing device, while the computing device is offline; and distributing the developed software to the computing device. In another aspect, a system, method, and computer program product for purchasing software online is provided. The system, method, and computer program product includes providing an interface for application programming in software for purchase on a computing device, while the computing device is offline; and distributing the software to the computing device. The service provider database 104b can include, for example, an SQL database server to store various types of information including, for example, end user information, vendor information, software application information, credit card information, coupon records and information, etc. The web server 104a, for example, automatically tracks (monitoring) device and name changes for the end users to detect improper use of such information, provides an online software store accessible by the end users, maintains a record of software purchases made by the end users, etc. Via the utility applications installed on the user computing devices as further described, the web server 104a can ensure that the end users are provided with the latest information, such as valid registration keys for

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purchased software applications, advertisements, product information, purchasing incentives, etc. Advantageously, the software vendors can use this feature, for example, to send coupons to owners of other software products. The software vendors are able to securely log on to the web server 104a at any time via a Web or other interface (e.g., a web browser, telephone, fax, e-mail, etc.), for example, to set up an account with the service provider, review purchase statistics, retrieve a list of registered users, handle returns, send complimentary registration keys, add to the list of offered software applications, modify software application descriptions, provide links for downloading the software applications, etc. The software vendors also can update the terms of the sales, company information, application name and price, etc. The updated information is automatically sent from the web server 104a to the end user computing devices 102 over the communications network 108, for example, when the end user performs a synchronization operation (e.g., a HotSync operation) between the end user PDA 102b and PC 102a. The examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. **Any responses to this action should be mailed to:**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

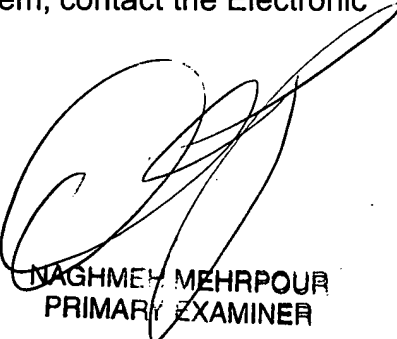
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro be reached (571) 272-7876.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

March 29, 2007



NAGHMEH MEHRPOUR
PRIMARY EXAMINER